

REMARKS

Allowable Subject Matter

In the Office Action at paper number 5, paragraph 3, the Office Action states that claims 11 and 13 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Examiner is thanked for the allowance of the subject matter of claims 11 and 13.

Claim 16 has been amended to further particularly point out and distinctly claim subject matter regarded as the invention.

Claim 11 has been cancelled, without prejudice.

New claim 17 also particularly points out and distinctly claims subject matter regarded as the invention. Specifically, claim 17 includes the subject matter of allowable claim 11 and the base claim 8, thus is now allowable.

The amendments here presented are made for the purposes of better defining the invention, rather than to overcome the rejections for patentability. Support for the amendments herein presented can be found in the specification and claims as filed. No new matter has been introduced as a result of the amendments. Reconsideration and allowance is respectfully requested in view of the amendments and the following remarks.

Claim Objections

The Office Action at paper number 6 paragraph 3 advised that should claim 12 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof (i.e. independent claim 8, and dependent claim 12).

The Examiner is respectfully reminded that in Applicant's response to the Office Action dated September 19, 2002, Applicant canceled claim 12. Therefore, it is not understood why the Office Action is making the above claim objections. It is respectfully requested the claim objection be withdrawn in view of the previously canceled claim 12.

The 35 U.S.C. § 103 Rejections

Claims 8-10, 12, and 14-16 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kretzner (U.S. Patent No. 1,957,143) in view of Groulx (U.S. Patent No. 2,129,129) and Carabias (U.S. Patent No. 933,360).

In the Office Action at paper number 3, paragraph 2, the Office Action asserts that Kretzner discloses all that is recited in the claims. Asserting that character "a" corresponds to the claimed "lower chamber member"; character "c" corresponds to the claimed "bowl portion"; character "z" corresponds to the claimed "vapor intake orifice"; characters "e"/"f"/ tubular part of character "a" correspond to the claimed "vapor intake conduit"; character "d" corresponds to the claimed "smoking pipe conduit"; character "b" corresponds to the claimed "upper chamber member," except it may not specifically disclose a lower screen member disposed in the bowl portion of the lower chamber and a generally-conical-shaped heat intake conduit. The Office Action further asserts that Groulx discloses a screen for tobacco pipes which is adapted to be inserted into the bowl

of a tobacco pipe for holding tobacco clear from the bottom of the pipe bowl (see figs). The Office Action further asserts that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the bowl of Kretzner to include the metal screen of Groulx in order to prevent tobacco particles from being drawn into the mouth, and also from plugging or clogging the passage through the stem and through which the smoke is drawn, as taught in Groulx (see page 1, col. 1, lines 12-16). The Office Action also asserts that while the device of Kretzner modified by Groulx may not disclose an upper chamber member including a generally-conical-shaped heat intake conduit, Carabias discloses an inhaler in the form of a smoking pipe which has a bowl B, the outlet of which is shaped in a generally conical manner (see fig. 3). The Office Action asserts that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the outlet portion of the upper chamber member of Kretzner (which would obviously be adapted to accept an output from a heat source such as a match or heat gun) such that it resembled the cone shape outlet of the pipe in Carabias since a pipe having a bowl outlet of said shape is known in the tobacco art as evidence by the disclosure of Carabias. The Office Action further asserts that while there may be no articulation in the combined references, that the lower and upper chambers are mated in a substantially airtight manner, it follows that this is the case since the chambers are joined in such a manner where in they are mated by external/internal threads on the surfaces of the respective members, such threading being conventional means in which to secure/connect two pieces in an airtight manner. The Office Action further asserts regarding claim 15, that while the device of the combined references may not have the exact threaded structure of that claimed, this limitation is not deemed to patentably distinguish the claim from the reference as the surfaces utilized to mate the

two members together are obvious modifications since it is well known to utilize these means in securing items together - whether the threading is located on the exterior or interior of the respective pieces. The Office Action further asserts regarding claims 12 and 16, that the screen of Groulx includes coiled wire 11, which would inherently serve to create turbulence in the smoke/air that passes between/through the coils and into the mouth of the smoker. The Office Action further asserts that alternatively, the coils 11 of the screen of Groulx would obviously cause turbulence in the smoke that passes over them since they occupy space in the pathway of the smoke which would result in an impediment to the smoke thus creating some disruption of an otherwise smooth flow of smoke into the mouth of the smoker. Applicant respectfully disagrees with the assertions in the Office Action.

It should be noted that claim 12 was previously canceled and therefore improperly rejected.

The Kretzner reference teaches a tobacco pipe with a porous insert piece *c* that is recessed in step form. The Kretzner reference teaches that the porous bottom insert piece *c* acts as a filter. The bottom insert piece *c* includes a central hole *z* which opens into a recess *e* from which radial channels *f* lead to an annular channel *h*. The annular channel *h* is formed between the bore of the shell *a*, and the outer wall of the insert pieces *b* and *c*. The Kretzner reference is silent with respect to a lower screen member disposed in the bowl portion of the lower chamber portion over the vapor intake orifice. The Kretzner reference is silent with respect to a vaporization chamber including a generally-conical-shaped heat intake conduit communicating therewith and having a heat intake orifice at a distal end thereof and adapted to accept output from a heat source (See Kretzner at lines 8-60 and FIGS. 1, 2, and 3).

The Groulx reference teaches a screen adapted to be inserted in a pipe bowl. A flat screen disc is mounted on a coil ring. The coil ring is positioned below the screen. The coil is configured to raise the screen up off of the bottom of the pipe bowl to prevent saliva from making the tobacco wet. (See Groulx at column 1, lines 49-55, and column 2, lines 1-5, FIGS. 1 and 2).

The Carabias reference teaches an inhaler attachment adapted to be fitted to a pipe or holder to receive a charge of medicament through which smoke is drawn. The Carabias reference teaches that the smoke passing through the sinuous passages absorb the medicament in the pockets of the passages and is inhaled. The Carabias reference teaches a bowl of a pipe or a cigar/cigarette holder B attaches to the chamber A. The Carabias reference teaches a mouth-piece C attached on the opposite end of the chamber A. The Carabias reference teaches that the bowl/holder B can accommodate a cigar or cigarette. (See Carabias at lines 5-110 and FIGS, 1, 2, and 3). The Carabias reference is silent with regard to being adapted to accept output from a heat source. The Carabias reference is silent with regard to being adapted to accept an output nozzle of a heat gun. The Carabias reference is silent with regard to modifying the element B in any manner.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q.

494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

The combination of the Kretzner/Groulx/Carabias references fail to disclose each and every claimed element. There is no at least one heated intake air turbulence member disposed between said heat intake orifice and said vapor intake orifice above said lower screen member as claimed in part in claim 16. Applicant does not agree with the assertion in the Office Action that the coiled wire taught in the Groulx reference is a turbulence member. However, the coiled wire of the Groulx reference is below the screen and is not the same structure as claimed. The coil of wire is specifically designed to lift the screen above the bottom of the bowl. It therefore is inserted into the pipe bowl below the screen and remains in that position. Thus, each and every claimed element is not taught or suggested in the prior art. Since each and every claimed element is not taught or suggested in the prior art, there is no *prima facie* case of obviousness.

Omission of an Element with Retention of the Element's Function Is an Indicia of Unobviousness. Note that the omission of an element and retention of its function is an indicia of unobviousness. *In re Edge*, 149 USPQ 556 (CCPA 1966).

The Kretzner reference teaches a porous bottom insert piece *c* with a recess *e* and radial channels *f* as well as a shell *a* with what the Office Action refers to as a tubular part. (See Kretzner at FIGS. 1, 2 and 3). The Office Action relies on these three elements to render the single claimed element of a vapor intake conduit. The claimed invention eliminates the elements of radial channels *f* and the tubular part of shell *a* while retaining the function of directing vapor to the smoking piece. As dictated by the patent case law, elimination of the elements *f* and part of *a* is indicia of nonobviousness.

Applicants assert that the combination of prior art references fail to make out a *prima facie* case of obviousness.

The Office Action at paper number 6 failed to address the above argument in response to the rejections of the Office Action at paper number 3. The Examiner is requested to address the arguments and provide evidence in support of the assertions of obviousness from the prior art cited or by Affidavit. Otherwise, withdrawal of the rejection is respectfully requested.

Additionally, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 USPQ 1300 (Bd. Pat. App. Int. 1993). The references when viewed by themselves and not in retrospect, must suggest the invention. *In re Skoll*, 187 USPQ 481 (C.C.P.A. 1975).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir 1990).

Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992).

A statement that modification of the prior art to meet the claimed invention would have been well within the ordinary skill in the art at the time the claimed invention was made because the references relied upon teach all the aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of

obviousness without some objective reason to combine the teachings of the references.

Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v VSI Int'l Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999).

The Office Action at paper number 6 failed to address the above argument in response to the rejections of the Office Action at paper number 3.

With regard to the combination of the Kretzner/Groulx reference and the Carabias reference in order to find a generally-conical-shaped heat intake conduit, there is no evidence in the prior art combination of references to combine the references. The Office Action relied on the assertion that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the outlet portion of the upper chamber member of Kretzner (which would obviously be adapted to accept an output from a heat source such as a match or heat gun) such that it resembled the cone shape outlet of the pipe in Carabias since a pipe having a bowl outlet of said shape is known in the tobacco art as evidence by the disclosure of Carabias. The Office Action relies on what is known in the art as motivation to combine.

However, the Kretzner reference has no teaching or suggestion to modify the top insert piece *b*. The Carabias reference may have an inherently conical shape, however the Carabias reference has no teaching or suggestion to modify a smoking pipe to accept an output nozzle of a heat gun. The case law controlling patent prosecution dictates that merely finding individual elements in the prior art and piecing them together in order to meet all of the claimed elements is not sufficient to prove a *prima facie* case of obviousness. The Office Action has not provided a reason to modify the top insert piece of the Kretzner reference to take on the shape of the Carabias reference. Merely finding a

unique shape of an inhaler bowl in the prior art does not rise to the level of teaching or suggesting a modification of another prior art smoking pipe. The above stated case law is clear in that regard. The Examiner is requested to address the arguments and provide evidence in support of the assertions of obviousness from the prior art cited or by Affidavit.

Dependent Claims

The argument and evidence set forth above is equally applicable here. Since the independent Claims 8 and 16 are allowable, then the dependent Claims 9-10, 13, and 14-15 must also be allowable. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988).

In view of the foregoing, it is respectfully requested that the rejection be withdrawn and it is respectfully asserted that the claims are now in condition for allowance.

Request for Allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,
Sierra Patent Group, Ltd.

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